

OSF 17  
--28. The coated medium of claim 15, wherein the coated medium and the ferromagnetic object form a laminate arrangement when held together via said magnetism.--

#### REMARKS

By this amendment, claims 23, 24, and 26 are canceled, claims 10, 13, 15, 19-22 are amended and new claim 28 is added to place this application in condition for allowance. Currently, claims 10-22, 25, and 26-28 are before the Examiner for consideration on their merits.

In the Office Action, the Examiner withdrew the previously-made rejection and rejected new claims 10-27 based on United States Patent Nos. 5,972,438 to Suzuki et al. (Suzuki) and 5,278,275 to Yatsuka et al. (Yatsuka). Claims 10, 13-15, 17, and 19-27 are rejected under 35 U.S.C. § 102(b) based on each of these patents. Claims 11, 12, 16, and 18 are rejected under 35 U.S.C. § 103(a) based on the same two patents.

In response to the rejection, independent claims 10, 15, and 20 are modified to better distinguish the invention over the applied prior art. New claim 28 is added to better define the coated medium aspect of the invention.

As previously pointed out, the invention permits the temporary attachment of things or objects using the coated medium. In one mode, a medium not normally having ferromagnetic properties, e.g., walls, wallpaper, cards, plastic sheets, etc., can retain a magnet, the very thing lacking in the prior art, see page 1, col. 10-16, page 5, line 5 to page 6, line 7, and page 9, lines 10-14. For example, a game board could hold a magnetic chess piece.

In another mode, a medium not normally magnetic can be made to be magnetic so that the medium can be supported by or adhere to a ferromagnetic support, see again page 1, lines 10-16, and page 6, lines 7-10. As an example, a card can adhere to a refrigerator.

In order to better emphasize the unique nature of the invention in this regard, independent claims 10, 15, and 20 have been revised. Claim 10 now further defines the step of magnetically and temporarily connecting the coated medium to a ferromagnetic object. As exemplified above, the object can be a magnet if the coated medium is not magnetized, or it can be merely ferromagnetic object if the coated medium is magnetized. Support for this amendment can be found in the sections of the specification identified above.

These advancements are not found in the newly-applied prior art and the distinctions between the claims as amended and this prior art are set out below under headings for each reference.

#### Suzuki

Suzuki is not related to the present invention. Suzuki's purpose is to make a magnetic recording medium that has a coding layer containing tamper-proof identifier coding information comprising designed patterns, letters, numerals, and bar-code type patterns.

In the rejection, the Examiner alleges that Suzuki discloses the claimed method, the coated medium, and the apparatus. The Examiner further alleges that the limitations found in dependent claim 11, 12, 16, and 18 are obvious variants thereof.

Applicant would first like to argue that there is no basis to allege that the limitations found in claims 12 and 18 are obvious variants of Suzuki. The Examiner must provide a factual basis for any rejection, and the mere assertion that these limitations are conventional cannot meet this burden. This is even more substantiated when considering that Suzuki is concerned with making a magnetic recording medium, whereas the instant invention is making a coated medium that can be adhered to another ferromagnetic object. The Examiner is called upon to clarify the basis for rejecting claims 12 and 18.

Applicant also asserts that Suzuki does not teach the limitations of claims 13 and 14, 19, 21, and 22. These claims all relate to producing a permanent magnet so that the medium not normally capable of supporting or adhering to a ferromagnetic object can now do so. The Office Action is silent as to the basis for rejecting these claims, and Applicant submits that a proper basis has not been made to reject these dependent claims.

Similarly, there is no valid basis to reject claims 17 and 27. The Examiner has not identified the basis for alleging that a paint is used as the binder of Suzuki, and these claims stand as separately patentable over this reference.

Referring again to independent claim 10, Applicant submits that Suzuki does not teach the claimed method. Claim 10 now requires that the coated medium be attached to another object, both temporarily and magnetically. No such attachment step is disclosed and Suzuki alone cannot anticipate claim 10.

Moreover, there is no reason why one would practice such a process with Suzuki. As noted above, Suzuki teaches a magnetic recording medium having one or more magnetic layers. Magnetic information is recorded on the layers, see for example, col. 13, lines 1-9. There is no reason why one of skill in the art would practice the method of claim 10 using the magnetic recording medium of Suzuki. Any such allegation is without a factual basis in the art, and cannot sustain a rejection under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a).

Applicant also asserts that Suzuki does not teach claims 15 and 20, as amended. Claim 15 now defines that the coated medium is applied such that the coated medium can temporarily link to a ferromagnetic object. Claim 20 requires that the mixing and spreading means form a coated medium that can temporarily and magnetically hold the coated medium and a ferromagnetic object together. There is no intent in Suzuki for such a use or apparatus, and Applicant contends that the claimed coated medium and

apparatus are fundamentally different than that disclosed in Suzuki when claimed in this way. Suzuki discloses magnetic layers of 6 and 12 microns in thicknesses, see col. 21, line 33, and col. 22, line 25. Nowhere does Suzuki disclose a magnetic layer-containing medium that can perform the claimed functions or an apparatus that makes such a medium, and Applicant contends that a proper basis has not been set forth to reject claims 15 and 20.

New claim 28 is also distinct from Suzuki. First, Suzuki does not teach the combined ferromagnetic object and the coated medium, and cannot anticipate this claim. In addition, there is no basis to allege that claim 28 is obvious in view of Suzuki. Given Suzuki's purpose of creating a magnetic recording medium carrying card, why would one combine it with a ferromagnetic object for temporary holding purposes. Applicant also questions whether such a purpose is even possible given Suzuki's magnetic layers, and the Examiner is requested to substantiate any further rejection of this claim with an objective basis in fact.

In summary, Applicant contends that Suzuki does not anticipate nor render obvious claims 10, 12, 13, 14, 15, 17-22, 27, and 28. Therefore, the rejections applied against these claims should be withdrawn.

#### Yatsuka

Yatsuka is also fundamentally different from the invention. Like Suzuki, Yatsuka teaches a method of making a magnetic tape using an improved polyurethane resin. The resin has improved travel properties and traveling durability when used as part of a magnetic recording medium, see col. 2, lines 27-32. The resin when combined with magnetic particles is applied to a PET film, see for example, example 13, col. 14, lines 15-17.

Yatsuka does not teach or suggest the method of claim 10 for the same reasons as set forth above for Suzuki. There is no disclosure of temporarily combining the tape of Yatsuka with another ferromagnetic object using magnetism, and this reference cannot anticipate claim 10. In addition, there is no motivation to do so, and Yatsuka cannot render claim 10 obvious.

Claims 15 and 20 are also patentable over Yatsuka. As with Suzuki, Yatsuka makes a magnetic tape. Such a tape does not anticipate the coated medium of claim 15 for the reasons set forth above. Similarly, the apparatus of Yatsuka does not make such a coated medium. Similar to Suzuki, Yatsuka produces a 4 micron coating, see Example 1, col. 9, line 26, and Applicant asserts that this is a structure that is not the same as that claimed. Thus, there is no basis to reject claims 15 and 20 under 35 U.S.C. § 102(b). Based on the fundamental difference between the invention and Yatsuka, there is also no basis to conclude that claims 15 and 20 are obvious variants of Yatsuka. Any such allegation is hindsight and cannot form a basis to reject these claims under 35 U.S.C. § 103(a).

Claims 12, 13, 14, 17, 18, 19, 21, 22, 25, 26, and 27 are also separately patentable over Yatsuka for the same reasons as set forth above for Suzuki. Yatsuka does not teach magnetizing the tape as specified in claims 13, 14, 19, 21, and 22; does not teach the paint binder as set forth in claims 17 and 27; does not teach the medium of claims 25 and 26, and does not teach the loadings of claims 12 and 18. Furthermore, there is no basis to allege that these claims are merely obvious variants of Yatsuka.

New claim 28 calls for the coated medium in combination with a ferromagnetic object via magnetism, and this combination is not taught or suggested by Yatsuka.

SUMMARY

In light of the arguments set forth above, Applicants submit that:

Suzuki does not establish a *prima facie* case of anticipation or obviousness against independent claims 10, 15, and 20 nor dependent claims 12, 13, 14, 17, 18, 19, 21, 22, 27, and 28. Likewise, Yatsuka does not establish a *prima facie* case of anticipation or obviousness against independent claims 10, 15, and 20 nor dependent claims 12, 13, 14, 17, 18, 19, 21, 22, 27, and 28. Accordingly, these claims along with the remaining dependent claims are patentable over the applied prior art.

Even though the rejection is made final, this amendment places this application in condition for allowance, and entry is respectfully requested. While a new claim is submitted, three claims are canceled and submission of the new claim is not grounds for denial of entry of this amendment. Furthermore, Applicant contends that the amendment to the claims did not precipitate the new grounds of rejection since the claims were merely rewritten to conform to Patent and Trademark Office claiming practice, and the instant rejection should have been non-final, and entry is requested for this reason.

Nevertheless, the Examiner is respectfully requested to examine this application in light of this amendment and pass all pending claims onto issuance.

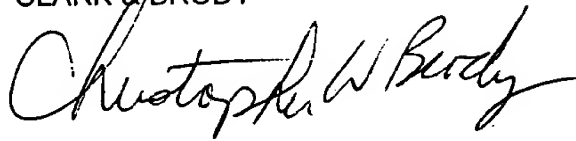
If the Examiner believes that an interview would help expedite allowance of this application, the Examiner is invited to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated April 24, 2002. Again, reconsideration and allowance of this application is respectfully solicited.

Serial No. 09/743,182

Please charge any fee deficiency or credit any overpayment to Deposit Account No.  
50-1088, including any extension of time fees and claim fees.

Respectfully submitted,  
CLARK & BRODY

A handwritten signature in cursive script, reading "Christopher W. Brody". The signature is written in black ink and is positioned below the typed name.

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MARKED UP CLAIMS UNDER 37 CFR 1.121

10. (once amended) A method of applying a coating to a surface of a medium to form a coated medium comprising the steps of:

a) providing a coating material by mixing a binder material suitable for being spread substantially and regularly over the surface and a ferromagnetic component;

b) providing a medium having the surface to be coated, the surface capable of receiving a substantially and regularly spread coating material; and

c) spreading a substantially constant thickness of the coating material onto the surface and allowing the coating material to set to form the coated medium, wherein the medium that is coated is one of a paper, a card, wallpaper, a flexible plastic sheet, a rigid plastic sheet, and walls; and

d) magnetically and temporarily linking the coated medium to a ferromagnetic object so that the coated medium and ferromagnetic object are held together.

13. (once amended) The method of claim 10, further comprising magnetizing the ferromagnetic component of the coating material so that the coated material remains magnetic after the magnetizing step such that the magnetized coated medium temporarily and magnetically holds the ferromagnetic object.

15. (once amended) A coated medium comprising:

a) a medium having a surface, the surface capable of receiving a substantially and regularly spread coating material, the medium being one of a paper, a card, wallpaper, a flexible plastic sheet, a rigid plastic sheet, and walls; and



b) a coating material as a mixture of a binder suitable for being spread substantially regularly over the surface of the medium and a ferromagnetic component, the coating material spread substantially and regularly over at least a portion of the surface;

c) the coated material being applied to the medium to form a coated medium that can temporarily and magnetically link to a ferromagnetic object so that the coated medium and ferromagnetic object are held together.

19. (once amended) The coated medium of claim 15, wherein the ferromagnetic component is permanently magnetized such that the magnetized coated medium temporarily and magnetically holds the ferromagnetic object.

20. (once amended) An apparatus for coating a medium comprising:

a) means for mixing a binder suitable for being spread substantially regularly over a surface of the medium and a ferromagnetic component to form a coating material, wherein the medium is one of a paper, a card, wallpaper, a flexible plastic sheet, a rigid plastic sheet, and walls; and

b) means for substantially and regularly spreading the coating material onto the surface of the medium and for allowing the coating material to set, the mixing and spreading means forming a coated medium that can temporarily and magnetically link to a ferromagnetic object so that the coated medium and ferromagnetic object are held together.

21. (once amended) The apparatus of claim 20, further comprising means for magnetizing the coating material so that the coating material remains magnetic after the

magnetizing step such that the magnetized coated medium temporarily and magnetically can hold a ferromagnetic object.

22. (once amended) The apparatus of claim 20, further comprising means for magnetizing the coating material so that the coating material remains magnetic after the magnetizing step such that the magnetized coated medium temporarily and magnetically can hold the ferromagnetic object, the magnetizing means having a magnetic strength to orient the ferromagnetic components of the coating material before the coating material sets.